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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/209,015 12/10/98 ABRAMSON N 101.957.156

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TM02/0702

EXAMINER

ROSSI, J

ART UNIT

PAPER NUMBER

2122

DATE MAILED:

07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/209,015

Applicant(s)
ABRAMSON et al.

Examiner
Jeffrey Allen ROSSI

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2122



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-19-1998 & 09-25-2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) NONE is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is responsive to the following communications: the application, filed 12-19-1998.
2. The disposition of claims is as follows: claims 1-17 are pending. Claims 1, 12, & 16 are independent. All claims are as originally filed.
3. The group art unit of the Examiner handling your case has changed. The current art unit is 2122. Use of this number on all correspondence helps us route communications to your case.

Claim Rejections - 35 U.S.C. § 112

4. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Dependent claims not explicitly addressed under this rubric are rejected based on the dependency on a rejected parent claim.

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5. Per independent claim 1, while a general conceptual diagram of the claimed software is demonstrated in **FIG. 2; FIG. 3** and **FIG. 6**, no software printout was supplied in appendix form. Applicants software is pivotal for the practice of the present invention to One Skilled in the Art to make and use the present invention. Without a computer listing, the present invention amounts merely to a conceptual outline of the present invention, and descriptive material absent of a clear teaching on how to make and use the invention. It would take undue experimentation for one of ordinary skill in the art to make and use the present invention, based on the disclosure as filed.

6. Claim 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Per dependent claim ; it appears that Applicants had reduced their invention to practice in JAVATM¹, and HTML in a scripted language. There is insufficient evidence to suggest that Applicants had *de facto* reduced his invention in both a scripted language and a compiled language. It is not known precisely which, because of the lack of written description. Without a computer code listing it impossible to tell to which code Applicants are referring, and whether they reduced this to practice in both compiled and scripted form. Therefore, Applicants lack a

¹JAVA is a registered trademark of the Sun Microsystems Corporation

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“written description” sufficient to display that Applicants *de facto* had position of the claimed invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

9. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

10. Claims 5-8 collectively recite the limitation “the program code” in . There is insufficient antecedent basis for this limitation in the claim. In fact, the software method of claim 1 inherently has computer code. However, since Applicants distinctly refers to “the computer code”, it is unknown if it refers to the entire coded portion of claim 1, or perhaps only to software components. This issue is exacerbated by the observation that HTML is set forth in independent claim 1, and it is not a “compiled programming language” (claims 5 and 8).

Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3, 5-9, 12-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/44695 to Apple Computer, Inc..

Claim dependency has been indicated in parentheses () as shorthand, and as a convenience for Applicants and as a reminder that the rejection of a dependent claim *implicitly* incorporates all elements of the rationale of the rejected base claim, *supra*.

13. Per independent claim 1; APPLE COMPUTER, INC discloses the claimed method for mapping input fields in a hypertext document to software components, the method comprising:
mapping (claimed mapping refers to 'action bindings 402 consist of a mapping between an event that Applet 201 triggers, for example... and an action on a server'—page 23, lines 13-15) input field names in a hypertext document to component properties when the hypertext document is rendered (claimed "names" refer to 'keys' that represent the data or state managed by applets 701'—page 23, lines 7-9; ' key is bound to a specific object or variable 704 in the server'—page 23, lines 10-12; (an example of a name for the variable is *approx.* line 10 on the TABLE, page 15; also "The dictionary {or snapshot of the keys and their current values} is used upon invocation of an action"—page 26, lines 7-10);

providing the rendered hypertext document to a user (HTML—page 15)

receiving from the user input field data in a named input field ('inputfield'—

TABLE—page 15; and

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using the mapping to determine an appropriate component property ('declarations file... provide declarations for the tag... initialize instance variables of an object and provide runtime information'—page 15, lines 34-35, See also TABLE 2) for the named input field and to call component methods for processing the input field data ('method 703 on the server is invoked'—page 23, lines 18-19).

14. Per dependent claim 2 (1), APPLE COMPUTER, INC further discloses: wherein the rendering includes emitting hypertext form tags with a current value of an inputfield pre-filled in ('List applet' {a list of items}'—page 21, lines 10-11; 'pull-down lists'—page 6, line 7).

15. Per dependent claim 3 (1), APPLE COMPUTER, INC further discloses: , wherein the mapping includes encoding the hypertext input form with a unique name ('name'—Table One) and registering the name (The WEBOBJECT tags in Table 1... provide a pointer to entries in a declarations file"—page 15, lines 31-35; the name having a value of 'inputfield' ... binds itself to the inputfield entry of the declarations file'—page 16, lines 32-35).

16. Per dependent claim 5 (1), APPLE COMPUTER, INC further discloses: wherein the program code is source code of a compiled programming language ("the invention can be practiced using other languages such as Objective C, C++...). *Note claims 5-8 have been given "broadest reasonable interpretation" based on a guess of Applicant's intended claim construction. See rubric "112 Rejections", supra.*

17. Per dependent claim 6 (1), APPLE COMPUTER, INC further discloses: wherein the program code is source code of a compiled programming language wherein the program code is source code of an interpreted programming language ("interpretative languages", "... scripts are typically

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used to provide the logic associated with a Web page”, see also table 3—page 18, lines 9, 13-17 *et seq.*).

18. Per dependent claim 7 (1), APPLE COMPUTER, INC further discloses : claimed ‘ wherein the program code is object code of a compiled programming language’ (“the invention can be practiced using other languages such as Objective C, C++...).

6. Per dependent claim 8 (1), APPLE COMPUTER, INC further discloses:, wherein the program code is object code of an interpreted programming language (“interpreted at runtime”—page 18, line 11).

9. Per dependent claim 9 (1), APPLE COMPUTER, INC further discloses: claimed ‘converting the submitted input field data to a correct data type’ (“HTML elements {including applets} are mapped to objects in an object-oriented environment”—page 14, liens 10-13).

19. Per independent claim 12 (1), APPLE COMPUTER, INC discloses claimed system for mapping hypertext input fields to software components comprising:

a preprocessor (In the reference as applied the claimed preprocessor is the CPU used to generate the code in table One, e.g., WEBOBJECT
name=INPUTFIELD></WEBOBJECT>... THE ABOVE HTML template includes tags for HTML, HEAD, BODY, and WEBOBJECT elements”—page 15, lines 23-25) for generating program code to register mappings between hypertext input field names and component properties and to emit hypertext form tags (authoring tool inherent in APPLE’s teaching relied upon, *supra.*) ;

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a name-space manager (*i.e.*, Associations **302**—page 22, line 9 *et seq.* in conjunction with Action Coordinator **301**; See also Applet group Controller—page 8, lines 19-20; “declarations file”—page 17, line 15 *et seq.*) for registering the mappings (Associations **302** and applets **201** include the ability to obtain the applet’s keys, obtain the key values”—page 22, lines 19-20; State bindings **401** include a list of ‘keys’ that represent the data or state managed by applets **701**... a key is bound to a specific object or variable **704** in the server to which it is synchronized”—page 23, lined 10-11; “Initially, when page is generated, all the state [sic.] for which there are state bindings are sent to the client... This initial synchronization ensures that the server’s data is used to initialize the web page”—page 20, lines 15-20; “initialize instance variables of an object”—page 15, line 35; and rendering the document so that the document can be provided to a user (TABLE ONE); and

a data handler (Applet Group Controller, Action Controller **301**), responsive to submitted input data with an input field name submitted by a user, for using the mappings to associate input field names with component properties (“HTML elements {including applets} are mapped to objects in an object oriented environment”—page 14, lines 9-11), and for calling appropriate component methods for processing the input data (“The server invokes the appropriate functions using the values transmitted from the Action Coordinator”—page 9, lines 3-5).

20. Per dependent claim 13 (12), APPLE COMPUTER, INC further discloses: ‘wherein the data handler converts the submitted input data to a correct data type’ (“HTML elements {including applets} are mapped to objects in an object-oriented environment”—page 14, liens 10-13).

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21. Per independent claim 16, APPLE COMPUTER, INC discloses a method comprising processing a hypertext document by identifying and storing input field names before sending the document to a user ("declarations file"—page 19, line 13; "key value pairs **701**"—page 23; lines 10-11)" "Association **302** is then connected to an applet **201** at step 507... At step **508**, all of the initial values {e.g., passed in through parameter tags in the HTML document} are extracted... The initial values are then placed into a dictionary of values located on the client's computer. The dictionary {or snapshot of the keys and there current values} upon invocation of an action"—page 26, lines 5-10) is used , and in response to receiving input data with input field names from the user, determining appropriate software component methods (method **703**—FIG. 7) for processing the input data by looking to the stored input field names ("This dictionary ... is used upon invocation of an action"—page 26, lines 6-10), whereby the input names for the input data are determined from the document without requiring that the names be separately provided in the document and in the software component (Each association **302** has the ability to obtain and set states for its corresponding applets **201** at runtime... Associations **302** and applets **201** include the ability to obtain the applets keys, obtain the key's values, and invoke an applet's action"—page 22, lines 15-20 *et seq.*; "Classes of objects are defined {in a declarations file} for each HTML element as well as the HTML template or page... At runtime, instances of the object classes are instantiated for the HTML elements defined in the HTML document"—page 14, lines 9-14 & 20-24)"). Note that the claimed software methods being referred to are the methods running remotely on the server ("... invocation of methods on the server... using Action Bindings **402**"—page 23, lines 1-5).

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Claim Rejections - 35 U.S.C. § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 10 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 98/44695 to Apple Computer, Inc.

24. Per dependent claim 10 (1), APPLE COMPUTER, INC further discloses wherein the determining includes iteratively processing input names associated with a component property to determine if data associated with any of the input names has been entered. (*inherent* in “Before an action is invoked in the server, any state that has changed in the client is transmitted back to the server {e.g., state may change when a browser user enters information in an input field of the web page}”—page 20, lines 20-25. The “inherence” relied upon is due to the observation that CPU processed data in clock cycles, and the ONLY way for the CPU to detect a state change would have been to continually check for the state change; See also “a timer may be utilized such that synchronization is to occur every {5} seconds”—page 21, lines 1-3). Should Applicant dispute the inherence of the claimed iterations, it would have been obvious to a Person Having

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Ordinary Skill In The Art, *i.e.*, PHOSITA at the time of the invention to iterate APPLE because it was suggested on page 21, lines 1-3, and in order to ensure synchronization as described by APPLE ("synchronization"—page 20, lines 19-23 *et seq.*)

25. Per dependent claim 14 (12), APPLE COMPUTER, INC, further suggests claimed : wherein the name-space manager includes a table for mapping a form to input field" (claimed table is *implicit* in mapping) , and for mapping input fields to a component property (*idem*). Should Applicants disagree that Apple explicitly discloses this claim limitation; "Official Notice" is hereby taken that it was notoriously well-known to map using a table. It would therefore have been obvious to PHOSITA at the time of the invention to employ tables in the mapping of APPLE COMPUTER, INC, in order to efficiently perform the look-up function inherent in the mapping of APPLE COMPUTER, INC, in order to reduce space.

26. Claims 4, 11, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/44695 to Apple Computer, Inc.

27. Claim dependency has been indicated in parentheses () as shorthand, and as a convenience for Applicants and as a reminder that the rejection of a dependent claim *implicitly* incorporates all elements of the rationale of the rejected base claim, *supra*.

28. Per dependent claim 4(1), APPLE COMPUTER, INC; lacks an explicit recitation of the receiving includes determining if the user submitted input field data is from a hypertext input form and bypassing input field processing if the determination cannot be made. However, it is

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suggested by APPLE COMPUTER, INC that “upon specified events on a browser by the user... certain actions may need to occur on a server. The present invention provides for the recognition of these events... and the invocation of the actions in the server. Therefore, since events are triggered by, for example, filling out a form it is suggested that if the determination of the filling of the form cannot be completed the action associated with the field will not be executed. It would therefore have been obvious to a **Person Having Ordinary Skill In The Art**, *i.e.*, PHOSITA at the time of the invention to bypass input field processing if no input to an HTML field is detected.

29. Per independent claim 11, APPLE COMPUTER, INC demonstrates all elements as applied in the rejection of independent claim 10, *supra*. “wherein the determining includes processing in order of priority stored with the mapping of the input field names”, APPLE COMPUTER, INC., lacks an explicit recitation of this feature. However, a priority of input fields is implied, because Action Coordinator 301 processes plural input fields, and because it processes “only those values that have changed since the last communication with the browser are compiled into the package”—page 29, lines 1-10. It is further implied in the observation that input field value mappings would not have been processed randomly, thus there is in inherent order. Since “priority” is generically claimed, it is believed that APPLE COMPUTER, INC implicitly meets this limitation. Otherwise, it would have been obvious to PHOSITA at the time of the invention to process input fields in a prioritized order in order to give preference to the executions of certain actions over others.

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30. Per dependent claim 15(12), APPLE COMPUTER, INC further suggests , wherein the name-space manager includes a *table* for mapping a form to input fields as described in detail in the rejection of dependent claim 14, *supra*. and for mapping input fields to a priority that determines the order in which the data handler processes the input field mappings. However per prioritizing the processing of mapping of the input field names”, APPLE COMPUTER, INC., lacks an explicit recitation of this feature. A priority of input fields is implied, because Action Coordinator 301 processes plural input fields, and because it processes “only those values that have changed since the last communication with the browser are compiled into the package”—page 29, lines 1-10. It is further implied in the observation that input field value mappings would not have been processed randomly, thus there is in inherent order. Since “priority” is generically claimed, it is believed that APPLE COMPUTER, INC implicitly meets this limitation. Otherwise, it would have been obvious to PHOSITA at the time of the invention to process input fields in a prioritized order in order to give preference to the executions of certain actions over others.

31. Per dependent claim 17; which depends on dependent claim 16 detailed, *supra*, the rational, including method and motivation for combination and achieving claimed “priority” are substantially identical to that as set forth in the rejection of independent claim 16, *supra*. Therefore, a significant copy/paste is hereby avoided by explicit incorporation of the rationale set forth with regard to the “priority” described in the rationale regarding claims 14-15, *supra*.

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Conclusion

32. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to

(703)-308-9051 (**formal** communications intended for entry)

Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**)

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

33. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey ROSSI whose telephone number is (703) 308-5213. The Examiner can normally be reached on Monday - Friday from 0830 to 1630 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark POWELL, can be reached on (703) 305-9703.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JR

2001-07-01


**PRIMARY PATENT EXAMINER
GEORGE B. DAVIS**